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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY	DOCKET NO.
09/242,525	02/17/99	SATO	S	11301-1480

IM52/0213
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EXAMINER

SERGEANT, R

ART UNIT	PAPER NUMBER
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1711

DATE MAILED:

02/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/242,525

Applicant
Sato et al.

Examiner
Rabon Sergeant

Group Art Unit
1711



☒ Responsive to communication(s) filed on Nov 22, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 46-58 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 46-58 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1711

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

With respect to all claims, the following variables appear frequently, and election is required for each species:

variable a) contains species: alkoxy groups or acetoxy groups, and species: primary amino groups, secondary amino groups, or acryloyl groups; and further contains subspecies: a-1), a-2), a-3), or ab;

variable b) contains species: carbonyl groups or nitrile groups, and is derived from species i), l), or m) or either n) or o) with either i), l), or m);

variable d) is derived from species c), c-1), or C);

variable e) contains species: amino groups or acryloyl groups;

variable o) contains species: two primary amino groups, two secondary amino groups, or a primary amino group and a secondary amino group;

variable i) contains species: carbonyl groups or nitrile groups;

variable k) contains species: monoalcohol, monoprimary amine, monosecondary amine, or monothiol;

variable y) contains species: alkoxy groups or acetoxy groups;

variable C) contains species: amino groups or acryloyl groups.

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With respect to the following specific claims, election is required for each species recited within each variable of the claim, as long as the election does not conflict with the aforementioned species:

Claim 51: variable: n) or o) and variable: i), l), or m);

Claim 52: species: acryloyl group containing monomer, hydroxyl group containing acrylate, or variable y);

variable: c), c-1), or C);

variable: A), D), a-1), a-2), k), or o); wherein variable A) is derived from

variable a) and variable b) and wherein variable D) is derived from variable a-3) and variable n) or o) and i), l), or m);

Claim 53: variable: B) or M); wherein B) is derived from d) and c), c-1), or C) and M) is derived from L);

variable: D), a-1), a-2), k), or o);

variable L) is derived from acryloyl group containing monomer, hydroxyl group containing acrylate, or variable y);

variable D) is derived from a-3) and n) or o) and i), l), or m);

variable A) is derived from a) and b);

Claim 54: variable: i), l), or m);

variable O) contains species: alkoxy groups or acetoxy groups;

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Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. Applicant is reminded that the respective elections should reflect a single inventive concept; therefore, it is possible that the election of a particular species will remove one or more claims from consideration. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. Currently, no claims are considered to be generic.
3. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The position is taken that the species within the respective variables fail to fall within a single class of compounds. Therefore, since a plurality of classes of compounds are presented, unity of invention is considered to be lacking.
4. Given the evident, extreme complexity of the election of species requirement, a telephonic election was not attempted.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Sergent whose telephone number is (703) 308-2982.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent

February 9, 2001



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